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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/740,706	12/19/2000	Bruce A. Schofield	2204/A78	5020

34845 7590 06/09/2004

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ACTON, MA 01720

EXAMINER

PHAN, HANH

ART UNIT	PAPER NUMBER
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2633

DATE MAILED: 06/09/2004

10

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/740,706

**Applicant(s)**SCHOFIELD, BRUCE A. **Examiner**

Hanh Phan

**Art Unit**

2633

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 December 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5-10 and 12-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-10 and 12-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. This Office Action is responsive to the Amendment filed on 04/15/2004.
2. The indicated allowability of claims 5, 12, 19, and 24 is withdrawn in view of the newly discovered reference(s) to Kiang et al (US Patent No. 6,449,407) and Hill (US Patent No. 6,542,656). Rejections based on the newly cited reference(s) follow.

### *Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-3, 5-10 and 12-28 are rejected under 35 U.S.C. 102(e) as being anticipated by Kiang et al (US Patent No. 6,449,407).

Regarding claims 1, 8, 16, 17, 22 and 28, referring to Figure 4, Kiang discloses an optical add/drop multiplexing apparatus comprising:

a photonic switching fabric (Fig. 4) operably coupled to drop but not add optical data streams; and

a combiner (i.e., multiplexer 404, Fig. 4) operably coupled to combine passed optical data streams from the photonic switching fabric together with added optical data

streams, wherein the combiner comprises filter logic for blocking an out-of-band optical data stream (col. 6, lines 5-58).

Regarding claims 2 and 9, Kiang further teaches the photonic switching fabric comprises single-sided mirrors configurable to drop but not add optical data streams (Fig. 4).

Regarding claims 3, 10, 18 and 23, Kiang further teaches the added optical data streams are not limited to the wavelengths of the dropped optical data streams (Fig. 4).

Regarding claims 5, 12, 19 and 24, Kiang further teaches the combiner is a passive coupler (Fig. 4).

Regarding claims 6, 13, 20 and 25, Kiang further teaches a demultiplexer operably coupled to de-multiplex, optical data streams from an incoming fiber and provide the demultiplexed optical data streams as inputs to the photonic switching fabric (Fig. 4).

Regarding claims 7, 14, 21 and 26, Kiang further teaches the photonic switching fabric is operably coupled to output the dropped optical data streams separately from the passed optical data streams (Fig. 4).

Regarding claims 15 and 27, Kiang further teaches each added optical data stream is maintained in-band using controls external to the combiner (Fig. 4).

### ***Response to Arguments***

5. Applicant's arguments with respect to claims 1-3, 5-10 and 12-28 have been considered but are moot in view of the new ground(s) of rejection.

**Conclusion**

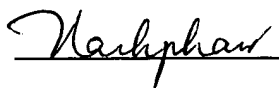
6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Hill (US Patent No. 6,542,656) discloses add/drop optical switches.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hanh Phan whose telephone number is (703)306-5840.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jason Chan, can be reached on (703)305-4729. The fax phone number for the organization where this application or proceeding is assigned is (703)872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-4700.



Hanh Phan

05/28/2004